

### REMARKS

In the Office Action, claims 7, 9, 10, 13, 14, 24-29, and 34-50 were examined, and were rejected as allegedly anticipated by or obvious over U.S. Patent No. 6,203,565 to Bonutti et al. With this paper, claims 9, 10, 26, 40 and 43 are being amended for purposes of improved clarity and accuracy, not to overcome any objection related to patentability. Claim 45 is being cancelled without prejudice to refiling in this or a continuing application. New claims 51-57 are being added. Reconsideration of all pending claims, and entry and favorable consideration of the new claims, is respectfully requested.

Independent claim 24 was rejected in the pending Office Action as allegedly anticipated by the Bonutti reference. Respectfully, it is noted that the Bonutti reference does not include all elements of claim 24. For example, Bonutti does not show or suggest the adhesive recited in the claim. As background, the Bonutti reference specifies that its usage of “bondable” and “bondable material” means flowing under application of heat, at least to a degree that the “bondable” material will fill available space. See Bonutti, column 3, lines 41-46. Examples of such materials are given at column 3, lines 54-65, and none of those materials are adhesives. In fact, the term “adhesive” is not used at all in the Bonutti reference.

Bearing those facts in mind, it is clear that the reference does not disclose an adhesive. The Office Action suggests that items 16, 22 and 170 are adhesives, but that assertion is not borne out in the reference. Item 16 is disclosed as a nut made of or including a “bondable material.” Item 22 is disclosed as an “area” at which a screw and plate both made of or including a “bondable material” are “bonded.” Item 170 is a fastener made of or including a “bondable material.” Thus, each of those features is specifically defined to be a material softened and flowable by application of heat. None of them are adhesives or include any part coated with an

adhesive. Moreover, the description in Bonutti shows the person of ordinary skill plainly that none of its parts utilize an adhesive. Bonutti only discloses heating a material so that it deforms and changes its physical properties, and presumably then hardens against two pieces. Nut 16 “is heated and softened to flow about the joint” between it and a plate. See column 4, lines 34-36. Area 22 represents a place where plate 18 and screw 20 flow together. See column 4, lines 40-44. Fastener 170 appears to be a washer fitted around a mandrel 162 that softened to flow around it. The items in the Bonutti reference relied on by the Office Action are used in essentially a soldering or welding process that softens and re-hardens material. They do not suggest use of an adhesive.

Claims 7, 9-10, 13-14, and 25-29 depend from claim 24, and are accordingly allowable due to that dependence. Further, several of those claims are also allowable over the Bonutti reference on their own merit. As one example, the Office Action asserts that claim 10 is anticipated, yet there is no explanation of how the Bonutti reference includes subject matter in that claims, and such subject matter is not evident from the reference. The elongate opening of claim 13 is likewise not specifically addressed in the Office Action, and does not appear in the reference. As seen in Figures 1, 1A & 2, none of items 10, 18 or 168 include an elongate opening. Moreover, given that the reference relies on softening and flowing of material in order to hold pieces together, one of ordinary skill in the art would not see the reference as disclosing an elongate opening because that would require a greater amount of material to flow into such an opening. Claim 14 recites a plurality of openings, but that subject matter is not discussed in the Office Action and is not seen in the drawings of the Bonutti reference. As to claims 25-27, Bonutti does not suggest any kind of adhesive, much less a pressure-sensitive adhesive, a particular chemical form of adhesive, or a two-part adhesive placed on separate orthopedic parts.

As already discussed, the reference instead requires heat for deforming material in its apparatus. For these and perhaps other reasons, claims dependent from allowable claim 24 are also independently allowable.

Independent claim 34 also recites use of an adhesive, to fixedly secure a fastener to a bone plate. For at least that reason, the Bonutti reference cannot anticipate claim 34. Dependent claims 35-36 and 38-39 are allowable due to that dependence. Further, claims 35 and 36 recite subject matter similar to that recited in claims 25 and 26, which as discussed above are not anticipated by Bonutti. Claims 38 and 39 recite applying an adhesive. The Office Action does not specifically point out how that step is shown in the reference, and a fair reading of the reference demonstrates that it does not disclose such a step. Accordingly, claims 34-36 and 38-39 are not anticipated by the Bonutti reference.

Claim 40 is believed to be distinguishable over the Bonutti reference as it stands, and thus no amendments are necessary. Nonetheless, in order to emphasize one ground for distinction, claim 40 has been amended as indicated above to more clearly recite its subject matter. No narrowing of the claim is desired.

For essentially the same reasons discussed with respect to claims 24 and 34, claim 40 is allowable over the Bonutti reference that does not disclose adhesives or adhesive bonding. The claims dependent from claim 40 are also allowable due to that dependence, and several are also allowable on their own merit. For example, claims 42-44 include subject matter similar to that in claims 25-27, discussed above, and are independently allowable over Bonutti for the same reasons noted previously.

The Office Action further asserted that claims 26, 29, 36, 43, 48 and 49 were allegedly obvious over the Bonutti reference. In addition to the remarks made above, which show that the

independent claims 24, 34 and 40 are not anticipated by the Bonutti reference, it is noted that the Office Action's *prima facie* case of obviousness is incomplete. First, no proper motivation to change the Bonutti reference, and no indication of the desirability to one of ordinary skill of any such change, was given in the Office Action. The Office Action asserts that choice of a particular adhesive can be held to be "within the general skill of a worker in the art . . . on the basis of its suitability for the intended use . . . ." That statement is not sufficient to establish a motivation for change or a *prima facie* obviousness case "without some objective reason" to modify the reference. MPEP 2143.01(IV) (case citation omitted). Further, the mere fact that a reference could be modified does not render the modification obvious unless the prior art also suggests its desirability. MPEP 2143.01(III). Most importantly, as discussed in detail previously, Bonutti discloses welding parts together, and has nothing to do with adhesives. Using an adhesive with the parts disclosed in the Bonutti reference would fundamentally change the bedrock principles of the Bonutti disclosure. Thus, not only is it not possible to modify the reference as the Office Action suggests, but the Office Action does not provide the "objective reason" or basis for desirability of such a modification required for a sufficient obviousness case. For these additional reasons the obviousness rejection made in the Office Action should be withdrawn.

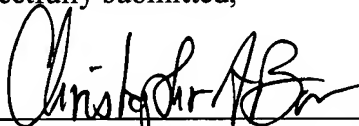
New claims 51-57 have been added to this application. Claims 51 and 52 are rewritten versions of claims 45 and 47, and are allowable at least because Bonutti discloses only heat welding of parts, not solvent bonding. The only mention of solvents in Bonutti is in a general description of what can go into a "plastic material" (column 3, line 65). There is no hint in the reference of using a solvent to change the physical or chemical properties of any part(s) of the Bonutti apparatus and/or to bind such parts. New claims 53-57 recite a bone plate, an adhesive,

and a fastener. Support for these claims is found throughout the specification and drawings, e.g. at paragraphs 0009, 0011, and 0060-0067 of the application and associated drawings, among other locations. No new matter has been added.

Applicants do not intend to limit the scope of pending or later-offered claims via the amendments herein. The claims are intended to have their full scope, including permissible equivalents and inclusion of all species, to which their language entitles them. Applicant respectfully submits the amendments and remarks in this paper have been made in an effort to expedite prosecution of this case, and do not necessarily comprise all possible arguments or positions in favor of patentability. In particular, Applicant does not concede or admit that the Bonutti reference adequately discloses other features of the claims of the present application.

In conclusion, reconsideration and allowance of this application is requested. Specifically, claims 7, 9, 10, 13, 14, 24-29, and 34-57 are in condition for allowance. If there are any outstanding issues, the examiner is invited to contact the undersigned attorney by telephone for their resolution.

Respectfully submitted,



---

Christopher A. Brown, Reg. No. 41,642  
Woodard, Emhardt, Moriarty  
McNett & Henry LLP  
Bank One Center/Tower  
111 Monument Circle, Suite 3700  
Indianapolis, Indiana 46204-5137  
(317) 634-3456

004002-003361.387484